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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,866	12/06/2000	Hideaki Yamanaka	200500US2	7895

22850 7590 11/03/2009

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EXAMINER	
SHRESTHA, BIJENDRA K	
ART UNIT	PAPER NUMBER
3691	

NOTIFICATION DATE	DELIVERY MODE
11/03/2009	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEAKI YAMANAKA, TERUHIKO MORIYAMA
and KATSUAKI KIKUCHI

Appeal 2009- 006239
Application 09/729,866
Technology Center 3600

Decided: October 30, 2009

Before, MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI and BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 2-19. We have jurisdiction under 35 U.S.C. § 6(b) (2002). An Oral Hearing was held on October 20, 2009.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for a digital content billing in which digital content such as, music files, video files and game software titles, is downloaded to a plurality of users through networks and a billing for each downloaded digital content is performed according to the number of execution times of the downloaded digital content. (Specification 1:6-12)

Claim 2, reproduced below, is representative of the subject matter on appeal.

2. A digital content billing system using a network, comprising:
a holder having digital content, which is set to become usable by an execution key, and holding a right to let a user use the digital content;
a distributor server obtaining the digital content from the holder and distributing the digital content to a user;
an advertiser possessing an advertising information piece to be provided for

the user;

and

an administrator server obtaining the execution key from the holder, obtain the advertising information piece from the advertiser, receiving an execution declaration of the digital content from the user, downloading the advertising information piece and the execution key to the user through the network, collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user, and paying an execution fee to the holder that corresponds to the number of execution times of the digital content.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Reilly	5,740,549	Apr. 14, 1998
Merriman	5,958,061	Sep. 7, 1999
Abecassis	2001/0041053 A1	Nov. 15, 2001
Nagano	PCT/JP00/01903	May 29, 2002
Maari	2004/0073451 A1	Apr. 15, 2004

The following rejections are before us for review.

The Examiner rejected claims 2, 5-8, and 17-19[1] under 35 U.S.C.

[1] The Examiner's rejection does not list claims 17 and 18 as part of any grouping of claims rejected under 35 U.S.C. § 103(a), but a reading of the detailed rejection on pp 13 -14 of the Answer indicates that these claims are

§ 103(a) as unpatentable over Maari in view of Nagano.

The Examiner rejected claims 3-4, 9-11, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano and further in view of Reilly.

The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as unpatentable over Reilly in view of Nagano and further in view of Abecassis.

The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano and further in view of Merriman.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 2, 5-8, and 17-19 under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano on the grounds that a person with ordinary skill in the art would understand that Maari and Nagano show all the claimed elements, and thus it would be a predictable result to use the teaching of Nagano of deriving revenue from advertisers to pay for content in Maari?

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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in fact rejected under 35 U.S.C. § 103(a) over Maari and Nagano.

invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner found that Maari discloses with respect to the independent claims all the recited elements but "… does not teach an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser; and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user." (Answer 5)

2. The Examiner however found that:

> Nagano teaches an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece

> from the advertiser (Nagano, Fig. 1, Advertising Data Input Device (10) and Advertising Data Database (14) Paragraph [0019], [023] and [0024]); and collecting an advertisement rate from the advertiser….

(Answer 6)

3. The Examiner thus found that "it would be obvious to one of ordinary skill in the art at the time the invention was made to include an advertiser possessing an advertising information piece" to the content of Maari." (Answer 6)

4. Maari at ¶[0071] discloses:

> The administration center 211 encodes and compresses the distributed content according to a predetermined compressing scheme and attaches, to this encoded and compressed content, the ID of this content (the content ID), proprietor information such as copyright holder, the amount of fee to be billed when this content is used, and the name of the virtual store that supplies this content to the user 200.

5. Nagano at ¶[0026] discloses:

> The system 10 is also provided with (1) an advertising-data identification/counting device 19, for identifying each advertisement displayed on the display device 18 in response to mouse clicks by the user and for counting the number of times each advertisement is clicked (in other words, the number of times the data is displayed), (2) an advertising-fee calculation/notification device 20, for calculating advertising fees based on the number of times each advertisement is clicked, as counted by the advertising-data identification/counting device 19, and for notifying the

> corresponding sponsors of the advertising fees periodically or with each access request.

6. Nagano discloses tying the transmitted advertising to the content of a user's personal data such that the advertising data conforms with the registered user's personal data e.g., hobbies, interests. [0033]

ANALYSIS

We affirm the rejections of claims 2-19.

Initially, we note that the Appellants argue independent claims 2, 17 and 19 together as a group. Correspondingly, we select representative claim 2 to decide the appeal of these claims, remaining independent claims standing or falling with claim 2.

Claim 2 recites *collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user.*

The Examiner found that Maari discloses with respect to the independent claims all the recited elements, but "… does not teach an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser; and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user." (FF 1)

The Examiner however found that "Nagano teaches an advertiser possessing an advertising information piece to be provided for the user;

obtain the advertising information piece from the advertiser; and collecting an advertisement rate from the advertiser...." (FF 2)

The Examiner thus found that "it would be obvious to one of ordinary skill in the art at the time the invention was made to include an advertiser possessing an advertising information piece" to the content of Maari. (FF 3)

Appellants argue however that:

> [t]he cited art to Nagano only discloses providing a payment based on a number of times that a user accesses an advertisement, and not digital content to which an advertisement is added. That is, in the claims as written advertisements are added to digital content that can be provided to a user. In the claimed invention, the number of times the digital content is executed is then counted and an advertiser is billed for those number of times. In the claimed invention, the advertiser is not billed based on the number of times an advertisement is clicked on or executed, but instead is billed based on the number of times digital content to which advertisement is added is executed.

(Appeal Br. 6)

We disagree with Appellants because the Appellants are attacking the Nagano reference individually when the rejection is based on a combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968). That is, the Examiner relies on Nagano only for the general teaching of obtaining revenues from an advertiser. (FF 2, 5) Further, we found that Maari discloses billing for content based on when this content is used. (FF 4) Nagano discloses tying

the transmitted advertising to the content of a user's personal data such that the advertising data conforms with the registered user's personal data, e.g., hobbies, interests. (FF 6)

Thus, we find that Maari and Nagano show all the claimed elements. There is no evidence of unpredictable results. Under these circumstances, we find that it would be a predictable result to use the teaching in Nagano of deriving revenue from advertisements to pay for content in Maari since Maari discloses paying for the content based on use (FF 4) which, when taken in combination with Nagano, would correspond to the concurrent viewing of content with an advertisement. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 1739 (2007).

Appellants do not provide a substantive argument as to the separate patentability of remaining dependent claims that depend from claims 2, 17 and 19, which are the sole independent claims among those remaining claims. Therefore, we also affirm the rejection of claims 3-16, and 18.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 2, 5-8, and 17-19 under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano.

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 3-4, 9-11, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano and further in view of Reilly.

We conclude the Appellants have not shown that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 103(a) as unpatentable over Reilly in view of Nagano and further in view of Abecassis.

We conclude the Appellants have not shown that the Examiner erred in rejecting claim 13 under 35 U.S.C. § 103(a) as unpatentable over Maari in view of Nagano and further in view of Merriman.

DECISION

The decision of the Examiner to reject 2-19 is AFFIRMED.

MP

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